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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,793	02/10/2000	Rob G. Parrish	P30321US	4384

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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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2167

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/501,793

Applicant(s)  
Rob G. Parrish

Examiner  
Andrew J. Fischer

Art Unit  
2167



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 1, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Sep 30, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on October 1, 2001 (Paper No. 8) for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/501,793 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Acknowledgments***

2. The amendment filed October 1, 2001 (Paper No. 10) is acknowledged. Accordingly, claims 1-57 remain pending.

### ***Specification***

3. The substitute specification filed October 1, 2001 (Paper No. 9) is acknowledged and has been entered.

### ***Drawings***

4. The proposed drawing correction and/or the proposed substitute sheets of drawings, stated by Applicants are not found in the Application. The Examiner notes the Transmittal Letter accompanying the CPA did not include additional drawings. Until the drawings are actually present in the Application, the Examiner can not consider them.

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5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The features must be shown or cancelled from the claims. No new matter allowed. The drawings are replete with these errors. Some examples follow:

- a. In claim 17, the pins “threadedly connected . . . .”
- b. In claim 18, the pins “integrally connected . . . .”
- c. In claim 37 “a mounting portion connected to a storage compartment surface, wherein the surface is . . . a bottom . . . .”

6. Corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 3 and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

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possession of the claimed invention. The claims are replete with 112 1<sup>st</sup> paragraph errors. Some examples follow.

a. In claim 3, the limitations, “for insertion through all of the receptacle and for engagement with the mounting member” are functional limitations with the prior art must be capable of meeting. The Examiner will never be able to find prior art where “a block is positioned for insertion through *all* of the receptacle . . . . [Emphasis added.]” Since, for example, the side walls are part of the receptacle, the prior art must be capable of positioning for insertion through the side walls. Conversely, the Examiner however has found prior art where the block is positioned for insertion through *some* of the receptacle. Therefore the claim limitation goes beyond what is found in the specification and is rejected upon a lack of support in the written description.

b. In claim 17, it is not known how the pins are threadedly connected. If Applicant shows where in the specification he describes to one of ordinary skill in the art how pins are threadedly connected or expressly states on the record that pins are threadedly connected is old and well known in the art (and provides appropriate evidence such as a U.S. patent), the rejection will be withdrawn.

c. In claim 18, it is not known how the pins are integrally connected. If Applicant shows where in the specification he describes to one of ordinary skill in the art how pins are integrally connected or expressly states on the record that pins are threadedly connected is old

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and well known in the art (and provides appropriate evidence such as a U.S. patent), the rejection will be withdrawn.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

a. In claims 1, it is still unclear whether the applicant is claiming the subcombination of a device or the combination of a device and a vehicle. Is the vehicle part of the claim? Is the female connector part of the claim? If yes, Applicant has a combination.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

b. Also in claim 1, it is still unclear whether the applicant is claiming the subcombination of a device or the combination of a device and a wall. Is the wall part of the device? If yes, Applicant has a combination. If no, this rejection remains.

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If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

c. Additionally in claim 1, it is unclear what element is "having a male trail hitch mounting member . . . ." It is not know if the device or the storage location has the mounting member.

d. In claim 37, it is still unclear whether the applicant is claiming the subcombination of a device or the combination of a device and a vehicle.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

e. Also in claim 37, it is still unclear whether the applicant is claiming the subcombination of a device or the combination of a device and a wall or bottom. Is the wall or bottom part of the device? If yes, Applicant has a combination. If no, this rejection remains.

If the applicant's intent is to claim only the subcombination, the body of the claim(s) must be amended to remove any positive recitation of the combination. If the applicant intends to claim the combination, the preamble of the claim must be amended to be consistent with the language in the body of the claim.

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11. Claims 10-15 and 47-56 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are prolix. See MPEP §2173.05(m), 8<sup>th</sup> Ed., August 2001. The claims include so many unimportant details (e.g. bolts that are threaded) that the scope of the invention is rendered indefinite. The Examiner notes however he has still made a good faith effort to properly address each limitation.

12. Claims 29-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claims are indefinite. Applicant has expressly stated the system is not patentably distinct from the apparatus. (Applicant's reply, Paper No. 4, page 3, line 6). Applicant now states claims 29-36 invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If the claims do in fact invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the scope may be different. Applicant's mutually exclusive positions (the system is not patentably distinct and 29-36 invoke 35 U.S.C. 112 6<sup>th</sup> paragraph) make no sense and are therefore clearly indefinite.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form/ the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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14. Claims 1-4, 6-11, 16, 17, 37-40, 42-47, 52, 53, and 58 as understood by the Examiner is rejected under 35 U.S.C. 102(b) as being anticipated by Blaser (U.S. 5,277,447). Blaser discloses a device with the following: a mounting portion (12b, 89, and 90 in figure 4); connected to a predetermined storage location (61); the predetermined storage location comprises a wall (wall of trailer 61 shown in figure 4); a trailer hitch mounting receptacle (91), connected to the mounting portion; a block (55); a friction member (55); wherein the mounting portion is fixed to the receptacle (once the machine is assembled, 95 will pull 61, they are therefore fixed); wherein the mounting portion is movably attached or pivotally attached to the receptacle (10 may be moved by rotating it 180°); the mounting portion has a substantially flat member (the upper member of tube 90 is flat); the mounting portion includes holes (73, 83, 47, ect.), cylinders (45); and pins (45).

15. Claims 1, 9-11, 37, and 45-47, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 102(b) as being anticipated by Carsten (U.S. 5,322,315). Carsten discloses a device with the following: a mounting portion (16); connected to a predetermined storage location (figure 1 is a storage location while the trailer is detached and parked in a garage); the predetermined storage location comprises a wall (the front wall of bumper 12 shown in figure 2); a trailer hitch mounting receptacle (16a) is connected to the mounting portion (inherent); the mounting portion comprises a substantially flat member (top of 16 shown in figure 1); the mounting portion includes holes (in which 26 is placed); and pins as cylinders (26).

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*Claim Rejections - 35 USC § 103*

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 5 and 41, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser in view of Kravitz (U.S. 5,735,539). Blaser discloses as discussed above and does not directly disclose threads (on 36) positioned to engage the mounting member (14). Kravitz teaches using threads to engage a mounting member to prevent it from moving.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Blaser as taught by Kravitz to include threads positioned to engage the mounting member. Such a modification would have allowed Blaser to use members with varying sizes such as ones slightly smaller since it would help prevent movement and rattling.

18. Claims 12, 13, 48, and 49, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser. Blaser discloses as discussed above and does not directly bolts. The Examiner took Official Notice (Examiner's rejection, Paper No. 5, paragraph No. 12) that cylinders (as bolts or pins) are old and well known in the art and used to attach two items together. Furthermore, the Examiner notes that all bolts with threads are

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threadingly connected. Since Applicant did not seasonably traverse the Official Notice statements, the Examiner took the statements to be an admission (Examiner's rejection, Paper No. 7, paragraph No. 12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klemetsen to include cylinders as bolts or pins connecting the elements. Such a modification would have made connection between the two easier and quicker to disconnect.

19. Claims 12, 13, 48, and 49, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser. Blaser discloses as discussed above and does not directly bolts. Again, the Examiner notes that all bolts with threads are threaded connected.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klemetsen to include cylinders as bolts or pins connecting the elements. Bolts and pins are art recognized equivalences. See MPEP §2144.06, 8<sup>th</sup> Edition, August 2001. The Examiner relies on Klemetsen (U.S. 5,476,279), Breslin (U.S. 5,593,172), McCoy (U.S. D 376,780), and Hollnagel (U.S. 3,630,321) to support this equivalence.

20. Claims 14, 15, 18-20, 50, 51, 54-57, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser. Blaser discloses as discussed above and does not directly bolts or pins integrally connected.

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However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Blaser to make the bolts integrally connected to the mounting portion. It is the Examiner's position that when the difference between the claimed invention and the prior art is that the prior art does not disclosed an element as being integral, as a matter of law, it would have been obvious to one having ordinary skill in the art to make the element integral. See MPEP §2144.04 V B<sup>1</sup> citing *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

21. The Examiner notes he takes Official Notice that all welded items are integrally connected.

22. Claims 15, 19 20, 51, 55, and 56, as understood by the Examiner, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Blaser. Blaser discloses as discussed above and does not directly bolts or pins which are welded or cast. The Examiner takes Official Notice that welding is a method of production and that casting is also a method of production. The Examiner also notes Applicant has claimed a product (i.e. a machine).<sup>2</sup>

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Blaser to make the bolts or pins welded or cast. "The patentability of a product does not depend on its method of production." *In re Bell*, 991 F.3d

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<sup>1</sup> MPEP 8<sup>th</sup> Ed., August 2001.

<sup>2</sup> "Products may be either machines, manufactures, or compositions of matter." MPEP §2106 IV B 2. (a), 8<sup>th</sup> Ed., August 2001.

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781, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (citations omitted); see also *Vanguard Prods. Corp. v. Parker Hannifin Corp.*, 234 F.3d 1370, 1372, 57 USPQ2d 1087, 1089-90 (Fed. Cir. 2000) (“The method of manufacture, even when cited as advantageous, does not of itself convert product claims into claims limited to a particular process”).

23. Claims 21-36, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over the rejections above in view of Applicant’s admission that “the inventions are not patentably distinct,” (Applicant’s reply, Paper No. 4, page 3, line 6).

#### ***Response to Arguments***

24. Applicant’s arguments filed with the amendment (Paper No. 10) have been fully considered but they are not persuasive or are moot in view of the new grounds of rejection.

25. Applicant argues the preamble should be given “some weight.” A careful review of the office action reveals the Examiner has always given the preamble some weight. See Examiner’s Office Action, Paper No. 7, paragraph 8, “Functional recitation(s) . . . have been given little patentable weight . . . .” The Examiner however maintains his positions on functional language and intended use (as stated in the previous Office Action) and finds Applicant’s arguments unpersuasive.

26. NOTE: A final rejection (Paper No. 7) was mailed out but did not include the substantive Office Action. The final was resent and the time period was restarted. The final rejection will be referred to as a single Office Action.

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27. In Paper No. 5, paragraph 12, the Examiner stated that he “takes Official Notice that cylinders (as bolts or pins) are old and well known in the art to attach to items together.” The following analysis is in response to this invocation of Official Notice.

a. In his response, Applicant stated (Paper No. 6, page 14), “Applicant responds with traverse to the Office Action.” Applicant then argues at length the various rejections. However, Applicant’s verbose 17 pages of remarks never once specifically traverse the Official Notice statement. In accordance with MPEP §2144.03, the Examiner, in his next Office Action asserted<sup>3</sup> the statement were an admission.

b. Applicant for the first time in his response (Applicant response, Paper No. 10, page 11, last paragraph) specifically traverses the Office Notice statement made back in the Examiner’s first rejection on the merits (Examiner’s rejection, Paper No. 5). This traversal is improper. MPEP §2144.03 clearly states, “Thus, Applicant is charged with rebutting the well known statement *in the next reply* after the Office action in which the well known statement was made. [Emphasis added.]”

c. Applicant argues his statement, “Applicant responds with traverse to the Office Action.” is sufficient to traverse the Office Notice. As a matter of law, the Examiner disagrees.

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<sup>3</sup> Paper No. 7, Paragraph 12 states: Since Applicants did not seasonably traverse the Official Notice statement(s) as stated in the previous Office Action (Paper No. 5), the well known statement(s) are taken to be admitted prior art. See MPEP §2144.03 or *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

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d. It is clear, MPEP §2144.03 does not expressly provide what constitutes traversal of the Official Notice statement. The Examiner notes however that in restriction practice, MPEP §818.03(a) clearly states that “a mere broad allegation that the requirement is in error does not comply . . . .”

e. Because MPEP §2144.03 does not contain what is a proper traversal, the Examiner adopts MPEP §818.03(a) to define what constitutes a proper traversal of an Official Notice statement. Furthermore, because Applicant argued at length about the various rejections in his next reply, the statement “Applicant responds with traverse to the Office Action.” is interpreted to traverse only those statements where express arguments were made.

28. The first final rejection (Paper No. 7) again rejected claims 37-58 under 35 USC §112 2<sup>nd</sup> paragraph—a combination/subcombination (Paper No. 7, paragraph 5a). Applicant responded (Amendment B, Paper No. 10) with an express statement that he intends to claim only the subcombination, “That is, Applicant is claiming the subcombination.” See Applicant’s remarks, page 5, last sentence, Paper No. 10. Because of Applicant’s express statements, the 35 USC §112 2<sup>nd</sup> paragraph rejections remain.

29. The Examiner notes that all claim limitations in claims 1-57 have their ordinary and accustom meaning. The Examiner is unaware of any express desire by Applicant to change the ordinary meaning of any claim term. However, if Applicant desires in any claim to NOT have its ordinary and accustom meaning, the Examiner respectfully request Applicant to acknowledge the claim term and to explicitly point out where in the specification he has defined the claim term.


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***Conclusion***

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure includes the following: Deerman (U.S. D 419,505); Mcwethy (U.S. 5,725,229); Mathews (U.S. 5,577,751); Hull et. al. (U.S. 4,938, 399); Taylor (U.S. 4,546,994); Abbott (U.S. 4,301,953); and Bruhn (U.S. 4,280,713).

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (703) 305-0292.

  
ANDREW J. FISCHER  
PATENT EXAMINER

 11/13/01  
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AJF  
November 7, 2001